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10/541,139	03/09/2006	Marc Chaussade	0070681-000029	4927
21839	7590	04/03/2009		
BUCHANAN, INGERSOLL & ROONEY PC				EXAMINER
POST OFFICE BOX 1404				PENG, KUOLIANG
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			1796	
NOTIFICATION DATE	DELIVERY MODE			
04/03/2009	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,139	<b>Applicant(s)</b> CHAUSSADE ET AL.
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12/5/08 Amendment.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/US/02)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. The Applicants' preliminary amendment under 37 C.F.R. 1.111 filed December 5, 2008 is acknowledged. Claims 1-11 and 13-15 are amended. Now, Claims 1-15 are pending.
  
2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Specification***

3. The disclosure is objected to because of the following informalities:  
In the specification (Amendments To The Specification, page 2), "if CA = CA I, then CA I is **different** from a ...." causes confusion because it is not clear as to how CA is CA I, yet CA is **different** from the CA previously defined as a silazane.

Appropriate correction is required.

### ***Claim Objections***

4. Claim 4 is objected to because of the following informalities:  
In Claim 4 (page 21, line 12), after "and", should there be "surfactants"?

Appropriate correction is required.

5. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1 (page 3, 5<sup>th</sup> line from bottom), it is not clear as what Fc' refers to.

In Claim 1 (page 4, line 12), “in particular” causes confusion because it is not clear as to what other applications than the ones set forth in the instant claim.

In Claim 1 (page 4, lines 16-17), it is not clear as to what “halogenated reagent” refers to.

In Claim 1 (page 4, line 19), it is not clear as to what the “compatibilizing agent” is used for? Also, it is not clear as to what the relationship between the compatibilizing agent and the foregoing halogenated reagent? After clarifying the relationship, Applicants are advised to consider the scopes of CA I and CA II in light of the clarification.

In Claim 1 (page 5, 5<sup>th</sup> line from bottom), it is not clear as to what the relationship between “route II” and “route I”?

In Claim 1 (page 6, 5<sup>th</sup> line from bottom), it is not clear as to what “passing through dried hydrophobic silica” refers to.

In Claim 1 (page 6, 3<sup>rd</sup> line from bottom), “a crosslinkable silicone material” causes confusion because when SM is SM4, there is no crosslinkable silicone material. Especially, the CA III is not necessarily a reactive silicone material.

In Claim 1 (page 7, line 8), it is not clear as to how low the molecular weight of the **low-molecular-weight siloxane** is.

For Claims 2-4, the above issues in Claim 1 are applicable.

Claim 2 recites the limitation "C1" in page 11, line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "C2" in page 16, line 7. There is insufficient antecedent basis for this limitation in the claim.

In Claim 3 (page 16, lines 7-8), it is very confusing in that CA = CA I, then CAI is different from a compatibilizing agent selected from silazanes because CA I is indeed a silazane as set forth in the page 13, line 17 of the instant claim.

In Claim 7 (line 2), it is not clear as to what “chosen” refers to.

In Claim 13 (line 2), it is not clear as to what “SM SM<sub>1</sub>” refers to.

In Claim 14 (line 2), it is not clear as to what “SM SM<sub>2</sub>” refers to.

In Claim 15 (line 2), it is not clear as to what “SM SM<sub>3</sub>” refers to.

***Claim Rejections - 35 USC § 103***

6. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (FR 2 817 262).

The following column and line numbers are based on Jackson's U.S. equivalent, US 2004 0044113.

For Claims 1-6 and 8-11, Jackson discloses a method for preparing a suspension of a silica in a silicone material usable for production of silicones (SM) crosslinkable by polyaddition **and/or** polycondensation where a compatibilizer (CA) such as organosilazanes, etc. can be employed. A non-reactive polysiloxane can optionally present. (Abstract, [0068]-[0095], [0114], [0157] and Examples) The polycondensation curable polysiloxane (SM) can have a formula (1) corresponding to the claimed CA III. ([0192], [0210] and [0287]-[0290]) The SM can be added after the addition of the compatibilizer. ([0089]) The silica can be in the form of a powder or the form of an aqueous slurry. ([0114]) Water , if added, can be in the amount described in [0081]-[0083]. For Claims 7 and 12, the BET of the silica (e.g., precipitated silica) and the viscosity of the suspension are illustrated in [0116] and [0303]. For Claim 13, the polyaddition SM is further described in [0175] to [0182]. For Claim 14, the polycondensation SM is further described in [0191] to [0220].

***Claim Rejections - 35 USC § 103***

7. Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canpont (WO 00/37549).

The following column and line numbers are based on Canpont's U.S. equivalent, US 6 462 104.

For Claims 1-5, 8-11 and 14, Canpont discloses a method for preparing a suspension of a silica in a silicone material including a reactive POS (SM), water, optionally a non-reactive POS to produce silicone compositions that can be cured by polycondensation where a compatibilizer such as organosilazanes, etc. can be employed. (col. 3, lines 27 to 54, col. 4, lines 29-36, col. 6, line 58 to col. 8, line 14 and Examples) The reactive POS can be represented by formula (1). (col. 6, line 59 to col. 7, line 7) The method is further elaborated in col. 4, line 37 to col. 6, line 48. A tin or titanium salt can be used as a catalyst. (col. 9, line 60 to col. 10, line 10) The incorporation of silicone material (SM) can take place after the silica (filler) has been treated with a compatibilizer (CA). (col. 3, lines 41-54) Canpont is silent on the claimed amount of the water. However, the amount of the water will affect the rate of hydrolysis of organosilazane and in turn the efficiency of the silica surface treatment and/or the curing rate of the silicone compositions. In other

words, the water amount is a Result-Effective variable. Therefore, it would have been obvious to incorporate water in whatever amount through routine experimentation in order to afford a composition having proper surface treatment of the silica and/or a desired curing rate. Especially, Applicants do not show the criticality of the water amount. See MPEP 2144.05 (II). For Claim 6, the amount of reacted POS with respect to the filler can be described in Examples. For Claims 7 and 12, the BET of a silica such as precipitated silica is described in col. 4, lines 16-28. The viscosity of the suspension is exemplified in col. 3, lines 1-11.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will

be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
March 27, 2009

/Kuo-Liang Peng/  
Primary Examiner, Art Unit 1796